

## REMARKS

### Rejections under 35 USC §112

Claims 6, 7 and 20-34 have been rejection under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. With regard to claims 6 and 7, it is stated that it is unclear how they further limit claim 1. Specifically, it noted that it is unclear how requiring an inorganic, non-matte, non-spherical powder, which may be an interference pigment, further limits claim 1.

Applicants respectfully traverse this rejection. In particular, attention is drawn to the language of claim 6, which expressly states that the composition further comprises the stated powder; in other words, in addition to the blue or violet interference pigment required in claim 1, claim 6 requires that there also be present another non-spherical powder, which may or may not be an interference pigment, but whatever it may be, it clearly constitutes an additional element in the composition, and therefore further limits the scope of claim 1. Contrary to the Examiner's position, a composition containing titanium oxide coated mica would not necessarily read on a composition comprising an interference pigment and a powder as in claim 6, unless it specifically contained both elements. Because claim 6, and claim 7 depending from it, both require the presence of an element not required in claim 1, they do further limit claim 1 and therefore comply with §112

Claims 6, 12-14, 17-20 and 24 have been rejected because the term "non-matte" is said to be indefinite. The Examiner acknowledges that the specification provides some examples of what is encompassed by this term, but does not provide guidance as to what is excluded.

The Examiner's position is believed to be in error. There is no statutory requirement that a term used in a specification or claim must define what is not included; as long as one skilled in the art can determine what is included in the scope of the claims, then the claims must be considered definite. The claims must be definite when read in light of the specification. *In re Moore*, 169 USPQ 236 (CCPA 1971). In the present case, the term "non-matte", at the risk of stating the obvious, by its plain meaning clearly refers to powders that do not confer a matte finish, and as the specification more explicitly explains, in the sentence bridging pages 4 and 5, these chosen powders are those that confer a some reflectance, but not overt shine. The specification further goes on to identify several examples of powders of this type. Thus, one skilled in the art is fully advised of what the claim does encompass, and by reasonable inference understands what it does not encompass. To take the Examiner's approach, if an applicant were to claim something "red", he would then be obliged to identify every one of the thousands of

shades and colors that are not encompassed in order to meet the standards of §112; clearly the definiteness requirement does not require this level of enumeration, and it should not be required of Applicants in the case where the term “non-matte” is so clearly understood in the context in which it appears.

Claims 20-24 are said to be indefinite because they recite percents of components but do not provide units of measurements. Claims 20 and 21 have been amended herein to state that all percentages are by weight of the composition; this amendment finds support in the specification in the examples, as well as in the remaining claims, where all percentages are expressed in terms of weight.

In view of the arguments presented above, withdrawal of the rejection of the claims under 35 USC §112, second paragraph, is respectfully requested.

#### Rejection under 35 USC §102(b)

Claims 1-8 and 12-17 have been rejected under 35 USC §102(b) as being anticipated by Kimura et al. In pertinent part, the rejection states:

Kimura et al teaches a cosmetic composition comprising an interference pigment that exhibit a blue interference color, metal oxides such as titanium dioxide and iron oxides and inorganic, non-matte, non-spherical powders such as bismuth oxychloride as instantly claimed. Kimura teaches that these compositions can be applied in order to hide hyperchromic portions of the skin. The application of these compositions to the skin inherently reduces the appearance of lines and wrinkles on the skin.

Applicants respectfully disagree with the Examiner’s position regarding Kimura. Although it is true that Kimura does teach compositions containing blue interference pigments, the claims in question are not drawn to compositions, but rather methods of using these compositions. The methods of use of the compositions of Kimura is quite distinct from the present methods. The Kimura use is for covering highly pigmented areas of the skin, whereas the present compositions reduce the appearance of lines and wrinkles on the skin. Although the Examiner has asserted that the compositions of Kimura inherently accomplish the same task, this position is legally insupportable. The law of inherency is well-established: for a reference to anticipate by inherency, the subject matter being claimed must undeniably and irrefutably flow from the prior art disclosure. *Hughes Aircraft Co. v. United States*, 8 USPQ 2d 1580 (Ct. Cl. 1988). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Oelrich and Divigard*, 212 USPQ 323 (CCPA 1981). In the present case, there is no probability, let alone a certainty, that an application of the compositions of Kimura to a hyperpigmented area of the skin

would result in the reduction in appearance of lines and wrinkles. In order for the compositions to achieve the present intended purpose, they must be actually applied to lines and wrinkles. The fact that Kimura recommends application to a very specific portion of the skin does not automatically, or even probably, result in its application to lined or wrinkled skin. The user population requiring treatment for hyperpigmentation is not necessarily in need of reduction of appearance of wrinkles, nor is hyperpigmented skin necessarily afflicted with lines and wrinkles. Since Kimura only recommends the use of the compositions for disguising skin discolorations, and makes no suggestion as to their application for any other purpose, there is not even a reasonable likelihood that the proposed Kimura use will result in reduction of the appearance of wrinkles. Therefore, the present claims fail to meet the required standards for a finding of inherency, and the rejection of these claims under 35 USC §102(b) must be withdrawn.

#### Rejection under 35 USC §102(e)

Claims 1-5, 9, 21-23, 25, 26 and 29 have been rejected under 35 USC §102(e) as being anticipated by WO 99/66883. The rejection states:

WO '883 discloses a composition for topical application of the skin that comprises at least on[e] interference pigment and at least one non-interference pigment. The compositions reduce the appearance of flaws and defects in the skin.... WO '883 discloses that the most common interference pigments are micas layered with 50-300 nm films of titanium dioxide, iron oxide or chromium oxide... The amount of interference pigment in the compositions is from about 0.05 to 90% by weight...

Additional pigments that may be incorporated into the compositions are... iron oxides... and titanium dioxide... Additional powders that may be incorporated into the composition in an amount from [sic] 0.001 to 20% by weight... One such powder is the inorganic powder calcium aluminum borosilicate. Example 1... teaches a composition comprising titanium dioxide coated mica, iron oxides and titanium dioxide... The reduction of appearance of lines and wrinkles... is encompassed by the teaching in WO '883 of the reduction of flaws and defects of the skin.

Applicants believe the present rejection to be in error. Attention is drawn to the scope of the present claims: all claims require the use of a blue or violet interference pigment to reduce the appearance of lines and wrinkles. While there is a general disclosure of interference pigments, there is no disclosure anywhere in the '883 reference of a composition containing a blue or violet interference pigment, let alone the use of same to disguise lines and wrinkles. Absence of a claim element from a prior art reference negates anticipation. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 USPQ 409 (Fed. Cir. 1984). Since in the full text of the '883 document contains no disclosure of a blue or violet interference pigment, then this fact alone

precludes a finding of anticipation of any of the claims, all of which require this element. Withdrawal of the rejection is therefore respectfully requested.

#### Rejection under 35 USC §103

Claims 1-30 have been rejected under 35 USC §103(a) as being unpatentable over either Kimura et al or WO '883, each in view of the other. The rejection is stated as follows:

Kimura et al. teaches all the limitations of the claims as stated above. It does not teach about 1-9% by weight of interference pigment, about 0.1 to 30% of a metal oxide, and about 2-20% of bismuth oxychloride. WO teaches all the limitations of the claims as stated above. It does not teach inorganic, non-matte, non-spherical powders.

Kimura et al. teaches inorganic, non-matte, non-spherical powders such as bismuth oxychloride as stated in the 35 USC 102(b) rejection above. WO '883 teaches a weight percent of components within the instantly claimed ranges as stated in the 35 USC 102(e) rejection above. WO '883 teaches ... that it is within the skill in the art to determine an optimum concentration of interference pigment in order to achieve a desired effect. Each reference makes up the deficiencies of the other.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare either the composition of Kimura et al. using the amounts of components as taught by WO '883 or the composition of WO '883 and add bismuth oxychloride as taught in Kimura et al. with the reasonable expectation of providing a cosmetic composition that reduces the appearance of flaws and defects of the skin.

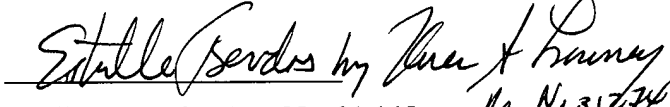
This rejection is respectfully traversed. Again, it is noted that the present claims are directed to a specific use of a specific type of interference pigment: it is not directed to a general use of interference pigments in disguising skin flaws. A careful reading of both documents cited will show that there is no suggestion, even in combination, of the use of an interference pigment having a blue or violet reflectance in reducing the appearance of lines and wrinkles. The disclosure of Kimura, while teaching compositions containing blue interference pigments in combination with iron oxides, speaks only to the use of such compositions in covering discolorations of the skin, and does not mention any ability to hide lines and wrinkles. The '883 reference is silent as to any use of an interference pigment having a blue reflectance, and in fact does not make any specific reference to lines and wrinkles. Since both references lack any teaching relating to lines and wrinkles, and the only specific use for the blue interference pigment is in hiding skin discoloration, even a combination of these two references in full would not provide a suggestion of use of a blue or violet interference pigment to hide lines and wrinkles. Therefore, the claimed uses of blue and violet interference pigments in the present application cannot be considered obvious in view of these disclosures.

With respect to the composition claims, it is believed that the motivation for combining the amounts specified in the '883 document with Kimura et al. cannot be found. Since the Kimura reference already discloses and expressly recommends a specified range of components, to achieve the specific purpose of covering hyperchromic skin. Since the Kimura reference is very specific as to its requirements, one skilled in the art would not be led to modify Kimura, lest the effect of hiding major skin discoloration be destroyed. Therefore, there is no incentive, and in fact, the teachings of Kimura can be considered disincentive, to substitute the proportions of components from the '883 document for those in Kimura. For the foregoing reasons, withdrawal of the rejection of claims 1-30 under 35 USC §103(a) is respectfully requested.

### CONCLUSION

The present claims are believed to be in condition for allowance, and prompt issuance of a Notice of Allowance is respectfully solicited. The Examiner is encouraged to contact the undersigned by telephone if it is believed that discussion will resolve any outstanding issues.

Respectfully submitted,

  
Estelle J. Tsevdos, Reg.No. 31,145      Reg. No. 31,145  
Kenyon & Kenyon  
One Broadway  
New York, NY 10004  
(212)425-7200

CLAIMS MARKED TO SHOW CHANGES

20(amended). The method of claim 17 in which the interference pigment is present in an amount of from about 2 to about 8%, the metal oxide present in an amount of about 0.1 to about 30%, and the bismuth oxychloride present in an amount of about 2 to about 10%, each by weight of the total composition.

21(amended). A skin-colored makeup composition comprising an interference pigment having a blue or violet reflectance in an amount of from about 1 to about 9% by weight of the total composition, combined with at least one metal oxide pigment and an inorganic powder.